

Appln No.: 10/789,781
Amendment Dated: February 9, 2005
Reply to Office Action of December 8, 2004

Looking at the merits of the anticipation rejection, the Examiner has again cited a reference that fails to meet the requirements for an anticipatory reference. As explained in *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972), for an anticipation rejection to be proper, the reference "must unequivocally disclose the claimed compound or direct those skilled in the art to the claimed compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." This means that where there are long lists of options to choose from, anticipation can only be found where the teaching of the reference guides the person skilled in the art to make the necessary choices to reach a combination that is later claimed.

In the present case, the claims are directed to liquid crystal polycarbonates. The reference does not disclose liquid crystal polycarbonates. It merely mentions liquid crystal polyesters. (¶ 41 and claim 42). While polycarbonates can be considered polyesters, not all polyesters are polycarbonates. Therefore, the Examiner may not infer that a liquid crystal polyester is a polycarbonate, nor that it is a polycarbonate with the components specified in the claims of this application.

Furthermore, the present claims require at least two species of aromatic diol selected from among a list of only 8 choices. The cited reference on the other hand has a long list of aromatic diols. This list includes many diols that are not among the 8 listed in applicants' claims. There is no express teaching of any combination that would meet the limitation of the claims of this application. The mere fact that a few of the possible combinations from the reference may fall within the scope of the present claims is not sufficient to establish anticipation.

For these reasons, the anticipation rejection is in error and should be withdrawn.

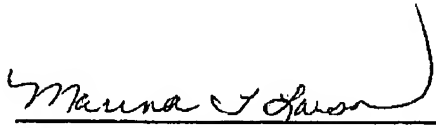
The Examiner also objected to claims 1 and 15 under 37 CFR 1.75 stating that they were duplicates. This objection is not understood since claim 1 is a method claim and claim 15 is a composition claim. Although the two are related in that the method of claim 1 can be used to produce the composition of claim 15, they can not be considered to be the same, and thus there is no basis for an objection under 37 CFR § 1.75.

Applicants again note that the Examiner has not confirmed consideration of the Information Disclosure Statement filed July 13, 2004. Return of an initialed copy of the Form 1449 with the next paper is requested. This paper is present in the image file wrapper system at the USPTO, so a duplicate copy is not provided.

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For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,


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